The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

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AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM BERSON and CLAUDE ZELLER

Appeal No. 2000-1185
Application No. 08/886,516

ON BRIEF

Before JERRY SMITH, DIXON, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1 through 3 and 5 through 11, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellants' invention relates generally to a method of identifying the source of an article of manufacture and more specifically, to a label which includes digitally signed

information for authenticating the article. The label includes various fields containing scannable and digitally signed verifying information such as description, authorized provider and expiration date of the article (Specification, page 4). The label further contains an unreproduceable pattern of which a tangible representation is digitally signed and incorporated in one of the fields along with the verifying information (Specification, page 5). Examples of the unreproduceable pattern are randomly distributed magnetic fibers and marks on the label. The information is digitally signed using the private key of a public/private key pair while the verification of the information may be achieved by the public key made available to those who wish to validate the source of the article (Specification, page 6).

Representative independent claim 1 is reproduced as follows:

1. A method for verifying the source of an article of manufacture, said method comprising the steps of:

a) preparing a label, said label comprising an unreproduceable pattern and information relating to said article;

b) describing said unreproduceable pattern and including said description with said information relating to said article;

c) encrypting at least a portion of said information relating to said article;

d) securely associating said article, said label, and a tangible representation of said encrypted information.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Huddleston	3,701,165	Oct. 31, 1972
Pastor	4,949,381	Aug. 14, 1990
Moore	5,592,561	Jan. 7, 1997
Salive et al. (Salive)	5,607,187	Mar. 4, 1997

Claims 1, 2, 10 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moore in view of Salive. Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Moore in view of Salive and further in view of that which is well known in the art. Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Moore in view of Salive and further in view of Huddleston. Claims 6 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moore in view of Salive and further in view of Pastor.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 10, mailed November 26, 1999) for the Examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 9, filed October 27, 1999) for Appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our careful review of the evidence before us, we do not agree with the Examiner that the claims are properly rejected under 35 U.S.C. § 103. Accordingly, we reverse.

With respect to the rejection of claims 1, 2, 10 and 11 over the combination of Moore and Salive, Appellants argue that neither reference teaches providing an unreproduceable pattern and encrypted information describing the pattern on a label and therefore, cannot suggest the claimed method of verifying authenticity. Appellants further point out that Moore teaches away from the claimed unreproduceable pattern since Moore's patterns are not unobtainable as the type of light suitable for detecting the dye used in the pattern is disclosed (Brief, pages 11 & 12). Additionally, Appellants argue that Salive does not support the rejection since the reference is directed to capturing data from labels affixed to multiple articles in a single operation and not prevention of counterfeiting (Brief, page 12).

The Examiner responds to Appellants' arguments by stating that Moore's printed identifier may be reproduced only after one detects/locates the mark, produces the specific chemical agent and is capable of duplicating the mark. Additionally, the Examiner points out that after the mark is read, the information must be decoded (Answer, page 7). The Examiner further notes that Moore and Salive are pertinent to the particular problem with which Appellants are concerned and address the process of tracking articles by labeling them (Answer, pages 7 & 8).

To resolve the issue of whether the "undetectable mark" disclosed by Moore is the same as the claimed "unreproduceable pattern and encrypted information describing it on a label," we must first determine the scope of the claim. Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). The inventor may define specific terms used to describe the invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "'set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning. In re Paulsen, 30

F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994)(quoting Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992).

We note that Appellants' claim 1 recites .

> a) ... said label comprising an unreproduceable pattern and information relating to said article;
>
> b) describing said unreproduceable pattern and including said description with said information ...;
>
> c) encrypting at least a portion of said information ....[Emphasis added.]

Claim 1 associates with an article a label that comprises an unreproduceable pattern as well as the information related to the article. Additionally, the claim requires that the information related to the article include a description of the unreproduceable pattern and be at least partially encrypted. Furthermore, a review of the specification (page 6, lines 1-7), shows that the pattern may be formed by random distribution of fibers which, absent extraordinary efforts, are unreproduceable. The specification points to a group of randomly distributed magnetic fibers as an example of unreproduceable, but detectable patterns. In fact, the combination of the unreproduceable pattern and its description that are included in the encrypted information makes the label unique to that specific article. In

other words, both an unreproduceable pattern and encrypted article information containing a description of the pattern are included in the label and must be verified together in order to determine authenticity.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). In doing so, the Examiner also has the burden of producing factual basis either supported by teachings in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Furthermore, the court states in Piasecki, 745 F.2d at 1472, 223 USPQ at 788 the following:

> The Supreme Court in Graham v. John Deere Co., 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under section 102 and 103" [citing In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)].

Additionally, in order to reach the conclusion that the claimed subject matter is prima facie obvious, the Examiner must further establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. In re Sernaker, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). The Federal Circuit further reasons in Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc., 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by Appellants.

A review of Moore shows that the reference relates to placing an identifiable mark on goods that, upon field inspection, determines authenticity and distribution track of goods. We find Appellants' summary of Moore to be reasonable and further note that upon exposure to a specific wavelength of light, the otherwise unobservable mark becomes detectable and provides encoded data related to the identity and source of the articles. In particular, using an invisible ink or dye, a unique

pattern is applied to the articles which incorporates an encoded input data entry comprising unique product identifiers. The pattern become detectable upon exposure to light with a specific wavelength and may be scanned and decoded in order to retrieve the input data and to determine authenticity of the article (col. 5, lines 41-59 and col. 15, lines 55-64). Therefore, Moore's unique pattern is not separate from the article information and itself includes encoded data corresponding to specific product information for identifying the article and its source.

Turning to Salive, we find that the disclosed machine-readable characters and/or coded indicia printed onto labels and affixed to articles are detected and recorded for identification and tracking (col. 1, lines 7-10 and 31-34). The captured image is stored in a computer for subsequent analysis and inventory tracking during and after handling. Therefore, Salive merely captures the encoded image of product data available on a label for tracking goods in a warehouse or during distribution. We find that Salive is not concerned with verifying the authenticity of the goods and does not teach a label having an unreproduceable pattern and encrypted article information that includes a description of the pattern.

We are unpersuaded by the Examiner's characterization of Moore's printed identifier as an unreproduceable pattern that is only reproducible if it can be located and detected. In view of the findings above, we conclude that neither Moore nor Salive teaches or suggests an unreproduceable pattern on a label and including its description in the article information that is encrypted and added to the label. The invisible, but detectable pattern of Moore itself incorporates and represents the encoded data relating to the source and tracking of the article. The labels in Salive are not for authentication and are detected for merely tracking the articles. Accordingly, we reverse the rejection of claims 1, 2, 10 and 11 under 35 U.S.C. § 103 over Moore and Salive.

With regard to the rejection of claims 3 and 5 through 9, we note that claims 5, 6 and 8 directly and claims 3, 7 and 9 indirectly depend from claim 1. After a review of Huddleston and Pastor, we find that neither the references nor any well known features relied upon by the Examiner teach or suggest a method for verifying authenticity of an article by providing a label having an unreproduceable pattern, including its description in information relating to the article and encrypting a portion of the information. As pointed out by Appellants, Huddleston

provides detectable markers in various garment parts, existence of which is sensed by the fabrication machinery causing specific functions to be performed upon detection of each marker. Pastor relates to electronic postage meters and determining the validity of an encrypted postal indicia printed on a mail piece by using a public key to decrypt and verify the data in the postal indicia. Therefore, neither Huddleston nor Pastor can cure the deficiencies discussed above with respect to Moore and Salive. Accordingly, we do not sustain the rejection of dependent claims 3 and 5 through 9 under 35 U.S.C. § 103 over Moore and Salive in view of different combinations with Huddleston or Pastor.

OTHER ISSUES

We note that claims 6 and 7 are identical to claims 8 and 9.[1] When more than one claim is presented in an application, 37 CFR 1.75(b) requires that claims differ substantially from each other. Therefore, we recommend that, prior to allowance, Appellants and the Examiner consider these duplicate claims and take the necessary steps to correct the problem.

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[1] Dependency of claim 6 was changed from claim 4 to claim 1 following the cancellation of claim 4 by the amendment filed April 27, 1999. The change made claim 6 identical to claim 8 and claim 7, depending from claim 6, identical to claim 9, depending from claim 8.

CONCLUSION

In view of the forgoing, the decision of the Examiner rejecting claims 1 through 3 and 5 through 11 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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